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EXAMINER

HUYNH, CONG LAC T

ART UNIT PAPER NUMBER

2178

DATE MAILED: 08/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/628,727

Applicant(s)

KRAUSE ET AL.

Examiner

Cong-Lac Huynh

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 23-31 and 34-44 is/are rejected.
- 7) ☒ Claim(s) 32 and 33 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: amendment filed 3/18/05 to the application filed on 07/28/00 which is a continuation of the application 09/015,660 filed on 01/29/98, now US Pat No. 6,154,757, domestic priority 1/29/97.
2. Claims 1-22 are canceled.
3. Claims 23-44 are added.
4. Claims 23-44 are pending in the case. Claims 23, 43-44 are independent claims.

Priority

5. Applicant's claim for domestic priority under 35 U.S.C. 119(e) is acknowledged. The instant application has the claimed priority to provisional application 60/036,305, filed 1/29/97.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 24-26, 29-31 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

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8. The feature of displaying the parameter in a location on the outline corresponding to the outline element or on the same line as the outline element (claims 25-26), the length of text referred to by the outline element is denominated in words, lines and pages (claims 29-31), and performing the operations on at least two different portions of the text (claim 24) are not in the specification of the invention.

9. Please show the portions of the specification that support the subject matter in claims 24-26, 29-31.

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claim 35 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 35, it is unclear what the "said outline element" is referred to in the limitation "designating an outline element hierarchically superior to said outline element", either the "an outline element" in claim 35 or the "an outline element" in claim 23 where claim 35 is dependent on.

Also, it is unclear why there is a need of said hierarchical superior.

Double Patenting

12. Claim 40 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 39. When two claims in an application are duplicates or else are so close in

content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

13. Applicant is advised that should claim 39 be found allowable, claim 40 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 23, 27-28, 34-35, 39-41, 43-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Powell et al., *Library News -- Engineering, Mathematics, & Physical Sciences Libraries*, Cornell University May/June 1995, pages 1-6, in view of Tryding (US Pat No. 5,880,732, 3/9/99, filed 4/29/97).

Regarding independent claim 23, Powell discloses:

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- presenting, on a display controlled by the computer system, and outline of the text (**pages 1-6**: the table of content is the outline of the followed text document)

wherein:

a word or phrase appearing in the text is an element of the text (**page 1**: the word "publish" or the phrase "how to publish information on a World Web Server" is an element of the text)

a plurality of elements of the text are included as elements of the outlines (**pages 1-6**: elements of the text such as Class Offering, Journal Review Underway, Thanks, GEOROM: Geophysics on CD-ROM, etc., are elements of the table of content, which is the outline of the text)

each element of the outline represents a portion of the text (**pages 1-2**: each element of the table of content such as Class Offering, Journal Review Underway, etc. represents a portion of the text)

elements of the outline comprise substantially less text than the entire text (**pages 1-6**: the whole table of content is less text than the entire text document)

substantially all portions of the text are represented by at least one element of the outline_(pages 1-6)

the positional relationship between the elements of the text is maintained on the outline (**pages 1-6**: the fact that the order of the portions of the text followed the order disclosed in the table of content indicates that the

elements of the text is maintained on the table of content, according to the table of content order)

- performing, in response to a signal from a user of the computer system, an operation on the entire portion of the text represented by at least one element of the outline (**pages 1-6**: it was well known in the art that when a user can click on an element of the table of content, which is correspondent to a signal from a user, to select a desired portion of the text, the system will effect on the entire text by moving the current cursor to the selected portion of the text and display said portion on the current display)

Powell does not disclose that the hierarchical relationship between the elements of the text is maintained on the outline.

However, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have to have modified Powell to include the hierarchical relationship among the elements to Powell since it was well known that the outline or the table of content of a document can be expandable by adding elements of the sub-levels to include more contents for the document, which forms the hierarchical relationship of the text maintained in the outline.

Powell does not disclose that the operation comprises calculating a parameter related to the length of the text referred to by the outline element.

Tryding provides parameters related to the length of the text performed by some commands including the displaying command (col 3, lines 18-52).

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It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Tryding into Powell since Tryding provides parameters related to the length of text, which implies that said parameters are calculated for different lengths of text, thus motivating to incorporate into Powell for applying different calculated parameters in performing different operations on the different portions of text.

Regarding claim 27, which is dependent on claim 23, Powell discloses that the elements of text presented on the outline relate to the structure of the text (**pages 1-6**: the fact that the order of the elements of text such as Class Offering, Journal Review Underway, etc. presented on the table of content is the same as the order of the elements of the table of content indicates the relation between the structure of the text and the structure of the table of content, which is the outline).

Regarding claim 28, which is dependent on claim 23, Power discloses that the outline is computer generated (page 1: the Power document is an electronic document, prepared in Word, and thus is computer generated).

Regarding claim 34, which is dependent on claim 23, Power discloses that the signal comprises designating said outline element (page 1: it was well known that when a user selects an outline element, which is a hyperlink, the outline element is highlighted, which shows designating said outline element).

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Regarding claim 35, which is dependent on claim 23, Power discloses that the signal comprises designating an outline element hierarchically superior to said outline element (page 1: when highlighting an outline element, said outline element is hierarchically superior to the other outline element in the table of content) .

Regarding claims 39 and 40, which is dependent on claim 23, Powell discloses that the text referred to by said at least one outline element of step (b) is all text appearing under a heading (pages 1-2: the text "How to Publishclass size is limited to 22" is all text appearing under the heading Class Offering).

Regarding claim 41, which is dependent on claim 23, Powell discloses that the text referred to by said at least one outline element of step (b) is an index (pages 1 and 4: the SciDex: Scientific American Cumulative Index in page 4 referred to by the same outline element in page 1).

Independent claims 43 and 44 are for a computer system and a computer memory storage device for method claim 23, and are rejected under the same rationale.

16. Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Powell in view of Tryding as applied to claim 23 above, and further in view of Spencer et al. (US Pat No. 5,603,021, 2/11/97, filed 9/2/94).

Regarding claim 36, which is dependent on claim 23, Powell and Tryding do not disclose that the signal comprises modifying the text referred to by said outline element. Spencer discloses editing the text referred to by an outline element (figure 3E, col 12, line 37 to col 13, line 5: editing the formula in the Edit field 355 referred from the outline 353).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Spencer into Powell and Tryding since Spencer provides the capability of editing the formula data referred from the outline element in 353 thus motivating to incorporate into Powell and Tryding for further editing as desired the text referred from an outline element beside creating a document containing outline with accompanied text and viewing said document.

17. Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over Powell in view of Tryding as applied to claim 23 above, and further in view of Brown, Using Netscape 2, Que Corporation 1995, pages 565, 567.

Regarding claim 37, which is dependent on claim 23, Powell does not disclose that the text referred to by said at least one outline element of step (b) is a figure.

Brown discloses that the text referred to by said at least one outline element of step (b) is a figure (page 567, figure 22.5: the Sample File – Videos is an outline element refers to a figure on the right pane).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Brown into Powell to show that the data referred to by an outline element can be an image or an figure, thus expanding the use of different types of data to be referred beside text as usual.

18. Claim 38 is rejected under 35 U.S.C. 103(a) as being unpatentable over Powell in view of Tryding as applied to claim 23 above, and further in view of Exley et al. (US Pat No. 5,724,577, 3/3/98, filed 6/7/95).

Regarding claim 38, which is dependent on claim 23, Powell and Tryding do not disclose that the text referred to by said at least one outline element of step (b) is a table.

Exley discloses that the text referred to by said at least one outline element is a table (figures 3, col 3, lines 32-50).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Exley into Powell and Tryding since the linking of an outline element into a relational table in Exley provides the advantage to incorporate into Powell and Tryding to further apply table beside text and graphics as usual when referring data by one outline element.

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19. Claim 42 is rejected under 35 U.S.C. 103(a) as being unpatentable over Powell in view of Tryding as applied to claim 23 above, and further in view of Bennett et al. (US Pat No. 5,815,392, 9/29/98, filed 8/22/95).

Regarding claim 42, which is dependent on claim 23, Powell and Tryding do not disclose identifying annotations to the portion of text referred to by the outline element. Bennett discloses identifying annotations to the portion of text referred to by the outline element (figures 5a-c, e-f, col 18, lines 22-37 : annotating data items within the hierarchical structure of the tailored outline).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Bennett into Powell and Tryding since Bennett discloses annotations to the portion of text providing in the hierarchical structure of the outline providing the advantage to include identifying said annotations to the portion of text referred to by the elements of the table of content of Powell, which is a form of outline, for further adding some notes explaining the outline elements or commenting the outline elements.

Allowable Subject Matter

20. Claims 32-33 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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21. The indicated allowability of dependent claim 14, which is now canceled and incorporated in independent claim 23, is withdrawn in view of the newly discovered reference(s) to Tryding (5,880,732). See the rejections.

Conclusion

22. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Jones et al. (US Pat No. 6,199,089 B1, 3/6/01, filed 2/23/96).

Wical (US Pat No. 6,112,201, 8/29/00, filed 8/29/95).

Fukuda (US Pat No. 6,338,075 B2, 1/8/02, filed 6/25/98).

Nishimura (US Pat No. 5,671,427, 9/23/97, filed 10/6/95).

23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cong-Lac Huynh whose telephone number is 571-272-4125. The examiner can normally be reached on Mon-Fri (8:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on 571-272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-4125.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Cong-Lac Huynh
Examiner
Art Unit 2178
8/1/05